

REMARKS

Claim 16 is amended as to form. New claim 24 is added. With this amendment, claims 1-6, 8-14, 16-18 and 21-24 are pending. Applicants submit that no new matter is added.

Claim Rejections under 35 USC §§ 112 and 101

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite, asserting that the claim does not set forth any steps involved in the method/process and it is unclear what method/process applicant is intending to encompass. Claim 16 is also rejected under 35 U.S.C. 101 based on similar reasoning. Applicants respectfully traverse. Nonetheless, in order to expedite prosecution, claim 16 has been amended to recite a particular process. Accordingly, the rejections should be withdrawn.

Claim Rejections under 35 USC §§ 102 and 103

Claims 1-6, 11-13, 16, and 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative under 35 U.S.C. 103(a) as obvious over Masuyama et al. (U.S. 6,013,709) in view of evidence presented in Ishihara et al. (JP 62-187708 and equivalent U.S. 4,680,353). (Numbered paragraph 4 of the office action.) Applicants respectfully traverse.

Masuyama does not specifically disclose the presently claimed composition:

- (A) a polyamide;
- (B) a syndiotactic monovinyl aromatic homo-polymer or copolymer;
- (C) a polystyrene copolymer or polystyrene graft copolymer; and
- (D) an impact resistance modifier.

Masuyama discloses over 20 compounds as its possible component (c) (col. 6, lines 7-29), and goes on to describe a great many additional more specific compounds (col. 6, line 30 through col. 8, line 65). Masuyama also discloses a large number of possible ingredients that can be used as its component (d). (See col. 9, lines 4-65). These and other laundry lists of possible ingredients can likely be combined to provide thousands or tens of thousands of specific combinations, only a small number of which are specifically

disclosed. Anticipation of the present claims requires more than this. Applicants submit that the sheer number of possible species that can be formed from various parts of Masuyama make it evident that the invention as claimed in the present application is not anticipated. (When the compound is not specifically named, but instead it is necessary to select portions of teachings within a reference and combine them, e.g., select various substituents from a list of alternatives given for placement at specific sites on a generic chemical formula to arrive at a specific composition, anticipation can only be found if the classes of substituents are sufficiently limited or well delineated. MPEP 2131.03) As explained in the prior response, all working examples, i.e. that which is in fact taught by Masuyama, use modified polyphenylene ethers. Thus, what Masuyama discloses in a manner that might anticipate a claim is a composition that includes a modified polyphenylene ether. Accordingly, Masuyama can not anticipate the present invention.

The present invention is also nonobvious in view of Masuyama. The properties sought to be attained are different, and the differences in properties observed are evidence of the differences in composition. For example, Masuyama discloses material with a long-term heat stabilization. (See, e.g., col. 1, lines 38-46.) This is demonstrated by the Examples which expose the material to 160°C for 1000 h and measure tensile strength/elongation on break and color change. These materials can then be used in an environment with high temperatures over long periods, for example motor components in a vehicle or components arranged close to the motor under the hood. The present invention is directed instead to materials requiring only short term thermal stability, although possibly at higher temperatures. Stability is required only during curing of the conductive primer the parts are dipped in, thus the parts have to withstand conditions in the curing oven of about 200°C for 30 min. After curing, the parts do not need to withstand additional thermal stress, only moderate warming up, such as heating in sunlight. This short term high temperature stability is neither taught, disclosed nor suggested by the compositions of Masuyama. Accordingly, the present invention is not obvious and the rejections should be withdrawn.

Applicants note that in setting forth the responses to arguments, the office action states that Applicant does not address the assertion that Masuyama teaches the polystyrene copolymer or polystyrene graft co-polymer, other than with arguments of

counsel. Applicants respectfully submit that the response and explanation as previously presented and as presented in a slightly different manner herein are not mere “arguments of counsel” but rather are efforts to have the proper legal standards applied in order to find the present claims allowable. When the proper legal standard is applied and considered together with the evidence and properties set forth in the present specification and the cited prior art (considered in its entirety), the present invention is novel and nonobvious.

Additionally, regarding claim 2, the examiner has construed “consisting essentially of” as equivalent to “comprising.” This is untenable and legally incorrect. “Consisting essentially of” and “comprising” are different terms with legally different scope and can not be considered equivalent. The transitional phrase “consisting essentially of” limits the scope of a claim to the specified materials or steps “and those that do not materially affect the basic and novel characteristic(s)” of the claimed invention. See MPEP 2111.03, citing *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). In particular, as described in the prior response, the present invention differs from Masuyama by not requiring the addition of “a copper compound having a specific structure and an iodine compound in specific amounts and in a specific ratio of the amounts” to attain the claimed properties. (See. e.g. Masuyama at col. 2, lines 18-21). Masuyama relies on the presence of these components and a composition omitting them would not be expected to provide the required properties without these components. This is what is excluded by use of the phrase “consisting essentially of.” In other words, the present invention provides the necessary thermal stability without the addition of “a copper compound having a specific structure and an iodine compound in specific amounts and in a specific ratio of the amounts.” Adding these components would thus change the composition and materially affect the basic and novel characteristics of the claimed invention. Accordingly, a composition omitting these components that Masuyama deems necessary can not be obvious in view of Masuyama. Thus, at least claim 2 is novel and non obvious over Masuyama.

To further distinguish Masuyama, applicants present new claim 24 that utilizes the transitional phrase “consisting of” which unequivocally excludes the use of a copper and iodine compound and is therefore novel and non-obvious.

For the reasons stated above, applicants submit that the rejection of claims 1-6, 11-13, 16, and 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative under 35 U.S.C. 103(a) as obvious over Masuyama et al. must be withdrawn.

Claims 5 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masuyama et al. in view of Steffl (DE 101 34 142). (Numbered paragraph 5 of the office action.) Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Masuyama et al. in view of Paeglis et al. (U.S. 5,569,516). (Numbered paragraph 6 of the office action.) Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masuyama et al. in view of Takado et al. (U.S. 5,114,522). (Numbered paragraph 7 of the office action.) Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masuyama et al. in view of Saito et al. (U.S. 5,104,937). (Numbered paragraph 8 of the office action.)

In response to applicants arguments, the Office Action states, for example, that “Applicant’s boilerplate argument is not found persuasive because it does not explain adequately why one having ordinary skill in the art would not have found it obvious to use the carbon black shown in Paeglis et al, as the carbon black filler in the composition of Masuyama.” (Page 9) This misses the point. In the obviousness rejections set forth above, the secondary references are cited for allegedly teaching some aspect of a dependent claim, i.e., the office action alleges that:

- Steffl teaches specific polymers of claims and 8-10
- Paeglis teaches a particular carbon black having a particular properties as recited in claim 14
- Takado teaches that certain resins can be used for automobile parts
- Saito teaches that certain resins can be injection molded to form for automobile parts.

Without confirming or denying that the references teach what is alleged, Applicants respectfully submit that the office action misses the point made by the “boilerplate argument” in the prior response.

In order for the combined references to render the present claims obvious, the combined references must teach each and every limitation of the claims, including the

limitations of the base claim from which the dependent claim depends. In the present application, the rejected claims depend from claim 1. As set forth above, when the proper legal standard is applied, Masuyama does not disclose, suggest or teach each and every limitation of claim 1. Accordingly, a proper rejection requires that the secondary reference provide the teaching that is missing from Masuyama with respect to claim 1. However, the secondary references cited above do not add, and the office action does not allege that they add, to Masuyama in way that provides the missing elements which is missing from claim 1. Thus, as set forth in the prior response, the secondary references, Steffl, Paeglis, Takado, or Saito, add nothing to Masuyama that would overcome the specific deficiencies described above. Accordingly, the rejections of claims 5, 8-10, 14 and 16-18 should be withdrawn.

Conclusion

All of the stated grounds of objection and rejection are believed to have been properly overcome, traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. An early notice indicating the allowability of claims 1-6, 7-14, 16-18 and 21-24 is respectfully requested.

The Examiner is respectfully requested to contact Applicant's undersigned Representative if necessary to place the application in condition for allowance.

Respectfully submitted,

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